

**REMARKS**

The Office Action mailed October 18, 2006, has been received and reviewed. Claims 6, 9-11, 14, 15, and 18-24 are pending in the application. Claims 11, 14, 15, 19, 20, 22, and 23 are withdrawn from consideration. Claims 1-5, 7, 16, and 17 are herein cancelled. Claims 6, 9, 10, 11, 14, 15, 18, 21, and 22 have been amended herein. New claim 24 is presented herein. Basis for new claim 24 can be found throughout the Specification and more specifically in original claim 6 and ¶ 17 of the specification. All amendments and claim cancellations are made without prejudice or disclaimer. Reconsideration is respectfully requested.

**Priority claim**

The Examiner, at page 2 of the Office Action mailed October 18, 2006, requested that the applicants provide a certified copy EP2001000200659 application. Applicants wish to inform the Examiner that the priority document has been requested and will be forwarded to the Office once it has been received.

**Specification**

The Examiner indicated that either clone t7-2-4.seq or t7-4-7.seq was mislabeled as both were labeled as SEQ ID NO: 161. Applicants note that appropriate correction has been made.

**Rejection under 35 U.S.C. § 112, second paragraph**

Claims 6, 7, 9, 10, 18, and 21 stand rejected under 35 U.S.C. § 112, second paragraph, as assertedly being indefinite. Specifically, it was thought that the phrases “polypeptide sequence” and “differentially expressed sequence” were unclear as to whether the “sequence” was a written sequence or a molecular sequence. Office Action mailed October 18, 2006, at pages 3 and 4. Applicants note that the rejection of claim 7 is moot as claim 7 has been cancelled herein. Applicants respectfully traverse the remaining rejections as herein after set forth.

Although applicants do not agree that any of the claims are indefinite, to expedite prosecution, claims 6, 9, 10, 18, and 21 have been amended herein. Specifically, these claims have been amended to recite “polypeptide” and “differentially expressed nucleic acid” in place of

“polypeptide sequence” and “differentially expressed sequence.” As such, applicants respectfully submit that claims 6, 9, 10, 18, and 21 can no longer be considered indefinite for the recitation of “polypeptide sequence” or “differentially expressed sequence.” Consequently, applicants respectfully request the withdrawal of the rejections of claims 6, 9, 10, 18, and 21 under 35 U.S.C. § 112, second paragraph, and reconsideration of same.

**Rejections under 35 U.S.C. § 112, first paragraph**

Claims 7, 18, and 21 stand rejected under 35 U.S.C. § 112, first paragraph, as assertedly failing to comply with the written description requirement. Specifically, it was thought these claims were directed to a very large genus of differentially expressed sequences, and that given the limited description provided in the Specification and the art, that one would not be able to envision a sufficient number of specific embodiments to describe the genus. Office Action mailed October 18, 2006, at pages 8. Applicants note that the rejection of claim 7 is moot as claim 7 has been cancelled herein. Applicants respectfully traverse the remaining rejections as herein after set forth.

Applicants respectfully note that claims 18 and 21 have been amended herein to depend from amended claim 9. Basis for the amendments can be found throughout the Specification and more particularly at original claim 7 as well as in ¶ 17. Claim 9, as amended, recites “wherein said differentially expressed nucleic acid comprises a nucleic acid encoding a polypeptide comprising at least 90% identity with SEQ ID NO:169.” Applicants respectfully submit that adequate written description exists for the genus of a nucleic acid comprising a nucleic acid encoding a polypeptide comprising at least 90% identity with SEQ ID NO:169 in at least ¶ 17 of the Specification as well as in SEQ ID NOs: 168 and 169. Consequently, applicants respectfully request the withdrawal of the rejections of claims 18 and 21 under 35 U.S.C. § 112, first paragraph, and reconsideration of same.

**Rejections under 35 U.S.C. §. 102**

Claims 7, 18 and 21 stand rejected under 35 U.S.C. § 102(b) as assertedly being anticipated by Chen *et al.* (The Plant Journal, Vol. 14, No. 3, pages 317-326, 1998), Deruere *et*

*al.* (The Plant Cell, Vol. 6, pages 119-133, 1994), Hiraga *et al.* (FEBS Letters, Vol. 471, pages 245-250, 2000), Chen and Chen (Plant Molecular Biology, Vol. 42, Pages 387-396, 2000), and Gen bank Accession No. X66942. Applicants note that the rejection of claim 7 is moot as claim 7 has been cancelled herein. Applicants respectfully traverse the remaining rejections as herein after set forth.

“A claim is only anticipated if each and every element as set forth in the claims is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987).

Applicants respectfully note that claims 18 and 21 have been amended herein to depend from amended claim 9. Claim 9, as amended, recites “wherein said differentially expressed nucleic acid comprises a nucleic acid encoding a polypeptide comprising at least 90% identity with SEQ ID NO:169.” Applicants respectfully submit that none of the references cited as anticipatory describe, either expressly or inherently, nucleic acid encoding a polypeptide comprising at least 90% identity with SEQ ID NO:169. *See, e.g., Ex parte Cox*, appeal no 2002-0870 (BPAI 2002)(attached hereto for your information). As such, applicants respectfully submit that the cited references cannot anticipate claims 18 and 21. Consequently, applicants respectfully request the withdrawal of the rejections of claims 18 and 21 under 35 U.S.C. § 102, and reconsideration of same.

### **CONCLUSION**

In light of the above amendments and remarks, applicants respectfully request reconsideration of the application. If questions remain after consideration of the foregoing, or if the Office should determine that there are additional issues which might be resolved by a telephone conference, the Office is kindly requested to contact applicants’ attorney at the address or telephone number given herein.

Respectfully submitted,



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